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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

QUELER, ADAM M

ART UNIT PAPER NUMBER

2178

DATE MAILED: 02/24/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/507,485

Applicant(s)

BECKER ET AL.

Examiner

Adam M Queler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-7,9-14,16-18 and 20-24 is/are rejected.
- 7) ☒ Claim(s) 4,8,15 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: Application filed on 12/15/2003.
2. Claims 1-24 are pending in the case. Claims 1, 10-12, 21-24 are independent claims.
3. The rejections of claims 1-24 under § 103 have been withdrawn.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-24 are under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "predetermined types characteristics" is deemed to be vague and indefinite. The possible grammatical error, or missing word(s), leaves the phrase indefinite and open to multiple interpretations. The specification implies that the phrase is directed to the characteristics of the underlying data, and that is how it will be treated for examining purposes only.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7. Claims 1-3,5-7,9-14,16-18 and 20-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Netscape® Communicator 4.08 (screenshots and help manual), © 1994-1998 hereinafter Netscape.

Regarding independent claims 1, 10-12, and 21-24, Netscape teaches that responsive to a computer receiving user selection of a hyperlink to download data, it downloads the underlying data represented by the hyperlink, namely the page (p. 39, "Using Caches" para. 1). It inherently records predetermined characteristics such as the URL, so it can be identified, and the dates so that it can determine if a page has been updated (p. 39, "Using Caches," para. 2). The cache is interpreted to be a database. Netscape discloses clicking a link, (p. 39, "Using Caches," para. 3), which is user input that includes the direction of a cursor proximate a hyperlink. Upon the click, Netscape discloses consulting the database to determine whether or not one or more users have previously selected it (p. 39, "Using Caches," para. 3). As this version of Netscape runs under WindowsNT (screen shot 4), which was common at the time of the invention, it inherently has a predefined access group consisting of one or more users. Netscape also discloses representing characteristics of the underlying data, namely the web page it describes, obtained previously (p. 39, "Using Caches," para. 3).

Regarding dependent claims 2 and 13, Netscape discloses displaying web pages, which inherently contain either text or graphics.

Regarding dependent claims 3 and 14, Netscape teaches a profile manager (screenshot 1) which allows selection between profiles, which each have their own cache as shown by the directories the caches are stored in (screenshots 2-3).

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Regarding dependent claims 5 and 16, Netscape discloses clicking a link, (p. 39, "Using Caches," para. 3), which includes depressing a mouse button.

Regarding dependent claims 6 and 17, Netscape runs under WindowsNT (screen shot 4).

Upon the access group having one user, the information obtained from the user would be the only information available so it would be obtained from the sole user.

Regarding dependent claim 7 and 18, Netscape runs under WindowsNT (screen shot 4). Upon the access group having multiple users, each user would use that same cache, as Netscape 4.08 does not recognize different users under WindowsNT. Therefore it would obtain information from any of the multiple users.

Regarding dependent claims 9 and 20, as Netscape stores the file as discussed in claim above, it inherently must have the characteristic of size.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-27 of copending Application No. 09/507,484. Although the conflicting claims are not identical, they are not

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patentably distinct from each other because they recite substantially the same subject matter differing mainly in scope and the use of the term "enhanced presentation capabilities. But the enhanced presentation capabilities would have been obvious to one of ordinary skill in the art at the time of the invention, because they are based on the downloaded underlying data, and would serve to better notify the user.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

10. Claims 4, 8, 15, and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and if a terminal disclaimer were filed to overcome the double patenting rejection(s), set forth in this Office action.

Response to Arguments

11. Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M Queler whose telephone number is (703) 308-5213. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AQ


STEPHEN S. HONG
PRIMARY EXAMINER